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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,588	12/17/2001	Charles D. Estes	CM03328J	6082

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MOTOROLA, INC
INTELLECTUAL PROPERTY SECTION
LAW DEPT
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EXAMINER

NGUYEN, DAVID Q

ART UNIT	PAPER NUMBER
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2681

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DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,588

Applicant(s)

ESTES ET AL.

Examiner

David Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7 and 9 is/are rejected.
- 7) ☒ Claim(s) 5 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-4,6-7 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Bodin (US 6387027).

Regarding claim 1, Bodin discloses a method for accessing extended capabilities in mobile communication device using a subscriber identity module (SIM), comprising: providing in the mobile communication device at least one code section for implementing an extended feature (see col. 3, line 37 to col. 4, line 58; and col. 3, lines 37-42); providing in the mobile communication device a directory address of the SIM for an extended feature directory (see col. 3, line 37 to col. 4, line 58); searching the SIM for a directory at the directory address (see col. 3, line 37 to col. 4, line 58; and col. 3, lines 37-42); searching the directory for a feature signature (see col. 3, line 37 to col. 4, line 58; and col. 3, lines 37-42); and enabling the extended feature if the feature signature is present in the directory (see col. 3, line 37 to col. 4, line 58; and col. 3, lines 37-42).

Regarding claim 2, Bodin also discloses wherein providing the directory address of the SIM, comprises providing the directory address of the SIM in a non-volatile, programmable

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memory of the mobile communication device (see col. 3, line 37 to col. 4, line 58; and col. 3, lines 37-42).

Regarding claim 3, Bodin also discloses wherein searching the directory for the feature signature comprises searching the directory for a feature signature file (see col. 3, line 37 to col. 4, line 58; and col. 3, lines 37-42).

Regarding claim 4, Bodin also discloses wherein searching the directory for the feature signature comprises searching the directory for an encrypted feature signature.

Regarding claims 6-7, Bodin also discloses wherein searching the SIM for a directory at the directory address is done upon initializing the mobile communication device (see col. 3, line 37 to col. 4, line 58; and col. 3, lines 37-42); wherein enabling the extended feature comprises enabling a dispatch calling feature (see col. 3, line 37 to col. 4, line 58; and col. 3, lines 37-42).

Regarding claim 9, Bodin also discloses wherein enabling the extended feature comprises enabling an ergonomic feature set to define the ergonomic operation of the mobile communication device (see col. 3, line 37 to col. 4, line 58; and col. 3, lines 37-42).

Allowable Subject Matter

2. Claims 5 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 5, Bodin discloses a method comprising all of the limitations as claimed in the independent claim 1. Bodin does not mention wherein if no directory is found at the directory address, or if no feature signature is found in the directory at the directory address, the method further comprising disabling the extended feature, as specified in claim 5.

Regarding claim 8, Bodin discloses a method comprising all of the limitations as claimed in the independent claim 1. Bodin does not mention wherein enabling the extended feature comprises enabling a graphical carrier branding logo to be displayed on a display of the mobile communication device, wherein the graphical carrier branded logo is stored in the SIM, as specified in claim 8.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Vehmas et al. (US 6356769 B1), Radio telephone arrangement with two memory modules and prioritization of their use

Leskinen (US 6085081), method for allocating a user identification

Humaid Darwish Bin Karam Abu Dhabi (EP 1051052 A1), Radio telephone with multiple SIM card readers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Nguyen whose telephone number is 703-605-4254. The examiner can normally be reached on 8:30AM-5:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika A Gary can be reached on 703-308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Nguyen


ERIKA GARY
PATENT EXAMINER